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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/767,323      | 01/28/2004  | Timothy Durnin       | 30004.01            | 5474             |

7590 03/10/2006

The Law Office of Steven G. Roeder  
5560 Chelsea Avenue  
La Jolla, CA 92037

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/767,323             | DURNIN, TIMOTHY     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Sebastiano Passaniti   | 3711                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,8-21,39-57 and 61-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,5,8-21,39-52,61,84 and 85 is/are allowed.
- 6) ☒ Claim(s) 53-55, 62-65, 69, 72, 75-81 is/are rejected.
- 7) ☒ Claim(s) 56,57,66-68,70,71,73,74,82 and 83 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office action is responsive to communication received 12/19/2005 –  
Amendment.

Claims 1, 4, 6, 7, 22-38 and 58-60 have been canceled, as directed.

Claims 2, 3, 5, 8-21, 39-57 and 61-85 remain pending.

#### ***Response to Amendment***

Applicant is once again reminded that while a formal rejection under undue multiplicity is not being drafted at this time, applicant is respectfully urged to further limit the number of claims, as it would again appear that an unreasonable amount of claims directed to one embodiment are currently present in this application. Amendments to the outstanding number of claims may result in clouding or confusing the pertinent issues in this application, which may be reason enough to raise the question of multiplicity of claims at some point in the future. Applicant is reminded of the content of 37 CFR §1.75 and MPEP 2173.05(n) stating:

#### ***37 CFR 1.75. Claim(s).***

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

\*\*\*\*\*

Where, in view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims which \*\* are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity based on 35 U.S.C. 112, second paragraph, may be appropriate. As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), "applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting

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phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. The rule of reason should be practiced and applied on the basis of the relevant facts and circumstances in each individual case." See also *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53, 55, 76 and 77 are rejected under 35 U.S.C. 102(e) as being anticipated by Solheim ('496). Reference is made to column 4, lines 43-60 and Figures 2-6, wherein Solheim discloses that at least two weights (206, 208) may be provided in the sole and form at least two sole inserts inserted within the sole region of the putter head. The materials of the inserts may be altered, as needed. Thus, the Solheim device anticipates inserts of varying specific gravity.

Claims 54, 78 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solheim ('496). To have selected and/or to have rearranged the inserts in the Solheim device for the purpose of desirably distributing the weight of the head would have been obvious in view of Solheim's stated suggestion that the material make-up of the inserts and the size and shape of the inserts may be altered as needed to compensate for non-symmetrical features of the head and to provide a properly aligned center of mass (col. 3, line 65 through col. 4, line 60). Thus, the claimed specific gravity percentages and the % volume requirement for the cavities are not deemed critical.

Claims 53-55, 62-65, 69, 72 and 75-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson ('006) in view of Solheim ('496). The patent to Johnson differs from the claimed invention in that Johnson lacks a specific disclosure of different materials for each of the sole inserts (40a, 40b). Note, Johnson does state that the rods (40a, 40b) may be fashioned of steel or any material having a greater density than the material of the putter body (col. 4, line 61 through col. 5, line 5). Solheim states that the material make-up of the inserts and the size and shape of the inserts may be altered as needed to compensate for non-symmetrical features of the head and to provide a properly aligned center of mass (col. 3, line 65 through col. 4, line 60). Thus, to have modified the device in Johnson by having selected and/or to have rearranged the inserts in the sole portion for the purpose of desirably distributing the weight of the head would have been obvious to one of ordinary skill in the art, given the teachings of Solheim. Moreover, the claimed specific gravity percentages and the % volume requirement for the cavities are not deemed critical. Also note, with reference to

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Figure 6 in Johnson, and considering that element (20) represents the striking face, it is clear that sole insert (40a) that is inserted within slot or cavity (42a) is located furthest from the face, as directed by instant claims 72 and 80. Specific to claim claims 75, it would appear that sole insert (40a) completely fills cavity (42a) and thus sole insert (40a) has the same volume as cavity (42a). Specific to claims 55, 62 and 81, note that the inserts (40a, 40b) are clearly seen as being positioned in both the heel and toe region.

#### ***Allowable Subject Matter***

Claims 56, 57, 66, 67, 68, 70, 71, 73, 74, 82 and 83 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2, 3, 5, 8-21, 39-52, 61, 84 and 85 are allowable over the prior art references for the reasons advanced by the applicant on page 17, lines 20-24 and page 19, line 15 through page 20, line 15 included with the remarks, received 12/19/2005.

#### ***Conclusion***

Applicant's arguments with respect to each of the objected to and rejected claims identified above have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-

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272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
March 6, 2006

  
**Sebastiano Passaniti**  
Primary Examiner